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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/558,575	04/26/2000	Wolfgang M. Strobel	P48-1229-1	9555

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EXAMINER

TSAI, HENRY

ART UNIT	PAPER NUMBER
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2183

DATE MAILED: 01/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

7 K

Office Action Summary

Application No.

09/558,575

Applicant(s)

STROBEL ET AL.

Examiner

Henry W.H. Tsai

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 30-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 30-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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DETAILED ACTION

1. Note This Office Action is issued in response to the DECISION ON APPEAL filed on 8/22/02
2. At pages 5-6 of the DECISION ON APPEAL, regarding the limitations of "each of said first and second cutting portion are defined in part by at least two helical cutting flutes extending longitudinally", Examiner considers the supports of the flutes(160) are shown in Figs. 8-10. However, in the specification, the limitations were not described for the written supports. The drawings should be also corrected to consist with the specification after being amended.

Regarding the art rejections, Examiner agree with the board that reference Arnold could still be used to anticipate the claimed invention by different interpretations.

Therefore, in view of the DECISION ON APPEAL filed on 8/22/02, PROSECUTION IS HEREBY REOPENED. A new ground(s) of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

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(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, In claim 30, lines 8-9, the limitations of "each of said first and second cutting portion are defined in part by at least two helical cutting flutes extending longitudinally" must be clearly shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

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Specification

4. The following is a quotation of the first paragraph of 35

U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 30-32 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In claim 30, lines 8-9. the limitations of "each of said first and second cutting portion are defined in part by at least two helical cutting flutes extending longitudinally" were not described in the specification.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 30-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Arnold (4,662,803)

Arnold discloses the claimed invention comprising: as shown in Fig. 1, a first cutting portion(18, near element 44) defining a first outer diameter and second cutting portion(12) defining a second outer diameter extending from and coaxial with the first cutting portion; and wherein the second cutting portion(12) defines a generally cylindrical, outer peripheral surface; each of the first cutting portion(18) and second cutting portion(12) being defined in part by at least two helical cutting flutes(23,24, 25, and 26, see Fig. 2) extending longitudinally shown in Fig. 1.

Note Arnold also discloses a tapered section(the partial portion of 18 between the first cutting portion(18, near element 44) and the second cutting portion 12); and the first cutting portion(18) and second cutting portion(12) being generally cylindrical shown in Fig. 1.

Note as described in Col. 3, lines 15-16, the flutes(23-26) on the forward portion(12) could be used to make a cylindrical enlargement of the hole prior to tapering. Therefore, the portion 12 is considered as the second cutting portion.

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Response to Arguments

8. Applicant's arguments mailed 12/19/00, 6/11/01 and 8/20/01 have been considered but are moot in view of the new ground(s) of rejection.

Contact Information

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Henry Tsai whose telephone number is (703) 308-7600. The examiner can normally be reached on Monday-Thursday from 8:00 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington can be reached on (703) 308-2159. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **TC 3700 receptionist whose telephone number is (703) 308-1148.**

10. In order to reduce pendency and avoid potential delays, Group 3720 is encouraging FAXing of responses to Office actions directly into: **the Group at fax number 703-872-9302; and Official faxes for After Final amendments should be sent to 703-872-9303.** This practice may be used for filing papers not

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requiring a fee. It may also be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into Group 3700 will be promptly forward to the examiner.

A handwritten signature in black ink, appearing to read 'Henry W. H. Tsai', written in a cursive style.

HENRY W. H. TSAI
PRIMARY EXAMINER

January 27, 2003